Attorney Docket Number: FSP0357
Application Number: 10/578,872

REMARKS

The Applicant thanks the Examiner for examination of this application. Please consider the remarks, infra.

Support for amendments to claims 3 and 4 (the independent claims) may be found at least at Par 47-51. "the meaning of markers may vary..indicate a position...a rating...proximity of an advertisement...proximity of rated content".

Further support is found at Par 58-66. "if there are not sufficient markers in ...the time interval...rendering is terminated."

The Applicant and the Examiner have now traversed the novelty of the claims more than once, applying a number of the same references more than once, in various combinations and using various rationale. The Applicant respectfully believes that the novelty of the claims has been more than adequately demonstrated, and respectfully requests allowance of all claims on the next office action.

35 U.S.C. 101

Claims 1-3 are rejected under 35 U.S.C. 101 because the claimed invention is allegedly directed to non-statutory subject matter. Claims 1-3 teaches "a system comprising: logic to..." where it is alleged that the spec discloses that the term "logic" refers to software.

It is not the policy of the patent office that software is nonstatutory per se. The specification identifies logic as software or hardware that implement instructions for a machine. Logic of such form is not an abstract idea, but a tangible device control structure.

Claims 1 and 3 describe inserting markers into content streams. This is describing transformation of a physical thing, namely content streams. It thus comprises statutory subject matter embodied in physical form (logic).

Claim 4 describe terminating rendering of an audio and/or video stream when an insufficient number of the markers are detected within a time interval. This is

transformative (terminating a A/V stream changes things) and it is also tied to a machine (one cannot terminate and A/V stream using abstract thought or pencil and paper; one must engage a machine to do so).

35 U.S.C. 112

Claims 4-16 are rejected under 35 U.S.C. 112, first paragraph, as allegedly failing to comply with the written description requirement. The claim(s) allegedly contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Regarding claim 4, Applicant amended claim to teach a currently rendering. Examiner cannot find the support for this 'limitation' on paragraphs 0047-0051.

The feature of scanning a stream that is currently rendering is superfluous and has been removed from claim 4. However, the Applicant respectfully notes written support for such a feature at least at Par 59-66. "if there are not sufficient markers in a ....stream, rendering of the stream may be terminated" (clearly the stream must be currently rendering in order to terminate rendering). See also Par 62, similar description. Par 65 (rendering may be re-enabled).

35 U.S.C. 102(e)

Claims 3-8 are rejected under 35 U.S.C. 102(e) as being allegedly anticipated by US Patent 7,055,166 to Logan et al (hereafter referenced as Logan).

Claims 3 and 4

Claims 3-8 have been amended to include the feature of terminating rendering of a stream with insufficient number of markers are detected within a time interval. The 'markers' are markers indicating position in the stream, rating, commercials, or restrictions.

The Office Action alleges that DePrez teaches a feature of terminating rendering of a stream when an insufficient number of markers are detected within a time interval. Paragraph 99 and Figure 7A are cited in support of the allegation.

Attorney Docket Number: FSP0357
Application Number: 10/578,872

The applicant respectfully disagrees. DePrez does not teach terminating a stream if an insufficient number of markers are received within a certain time interval.

More specifically, DePrez does not teach terminating a stream if an insufficient number of markers indicating position, rating, commercials, or restrictions are received within a certain time interval.

Claim 5

Regarding Claim 5, Logan does not teach the use of markers to identify restricting conditions such as proximity to the end of an audio or video stream. Logan teaches markers that identify commercial segments. These markers do not indicate where those commercial segments are in relation to the stream start or end.

35 U.S.C. 103(a)

Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over US Patent 5,721,829 to Dunn et al (hereafter referenced as Dunn) in view of US Patent 6,115,057 to Kwoh et al (hereafter referenced as Kwoh).

Claim 1

Claim 1 describes server logic inserting markers into content streams, the markers comprising position data in the streams, and logic to receive a marker obtained from the stream comprising position data where the set top box has paused or suspended viewing.

One of relevant skill would not be led by Dunn and Kwoh to produce such server logic. Dunn teaches the set top sends the server a pause signal, and the server saves a position indication, like a time stamp or pointer. Dunn fails to teach that the server inserts markers comprising position information into the stream, or that the STB returns a marker obtained from the stream with the pause message.

Kwoh merely teaches the use of rating markers around content segments. Including such markers with a pause message to the server would not reach the present claims, because the content markers do not comprise position information. There is no suggestion in Kwoh that they ever are included in messages to the server, let alone pause messages. There is no suggestion how one could pause within a content segment, because there would be no rating marker there. In short, the rating markers of Kwoh are

unsuitable for position markers returned with a pause message (they comprise no position information), one skilled in the art would not be led to do so, and doing so in combination with the teachings of Dunn would fail to teach the server of claim 1.

Claim 2

Claim 2 builds upon the novel features of claim 1 and is thus novel for at least the same reasons, supra.

Claims 10-15 are rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over Logan in view of US PG Pub 2003/0188316 to DePrez (hereafter referenced as DePrez).

Claims 10-11, 13-15

These claims are patentable over the cited references for the reasons given for claim 4, supra.

Claim 12

Regarding Claim 12, Logan does not teach the use of markers to identify restricting conditions such as proximity to the end of an audio or video stream. Logan teaches markers that identify commercial segments. These markers do not indicate where those commercial segments are in relation to the stream start or end. Deprez does not cure this lack, nor would it lead one of relevant skill and reading Logan to such a feature.

Claim 12 is also patentable over the cited references for the reasons given for claim 4, supra.

Claims 9 and 16

Claim 9 is rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over Logan in view of Kwoh. Claim 16 is rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over Logan in view of DePrez as applied to claim 10-15 above, and further in view of Kwoh.

These claims are patentable over the cited references for the reasons given for claim 4, supra.

Attorney Docket Number: FSP0357
Application Number: 10/578,872

Conclusion and Remarks on Final Rejection

In view of the above amendments and remarks, the Applicant believes that this application is now in condition for allowance. The Applicant respectfully requests that a Notice of Allowability be issued covering the pending claims. If the Examiner believes that a telephone interview would in any way advance prosecution of the present application, please contact the undersigned.

The Applicant and the Examiner have now traversed the novelty of the claims more than once, applying a number of the same references more than once, in various combinations and using various rationale. The Applicant respectfully believes that the novelty of the claims has been more than adequately demonstrated, and respectfully requests allowance of all claims on the next office action.

The Applicant respectfully asserts that final rejection of the claims would not be proper if such rejection is grounded in new art or rationale. This is so because the Applicant's amendments did not touch claim 1; regarding claims 3 and 4, Applicant's amendments substantively amount to combining features of cancelled claim 10 into these independent claims. Therefore, the Applicant's amendments would not necessitate new grounds of rejection not already presented by the Examiner in prior office actions.

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